

Appl. No. 09/764,163

PATENT**REMARKS****A. Status of the Claims**

Claim 80 has been amended to incorporate the subject matter of former claim 82. Claim 84 has been amended to correct antecedent basis in light of the amendments to claim 80. Therefore, no new matter is added with this amendment. Claims 81-83 are canceled without prejudice to future prosecution. Therefore, claims 80, and 84-88 are pending with entry of this amendment.

B. Written Description

Claims 80-84, and 88 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that the specification working examples and figures are not sufficiently "representative of 'circularly permuted marker proteins' claimed in the instant claims." See Official Action mailed April 21, 2005, page 9, second paragraph. However, the Examiner acknowledges that Applicants' specification "discloses circularly permuted *β-lactamase* marker proteins and circularly permuted *β-lactamase* marker proteins covalently linked to interactor domains." See Official Action mailed April 21, 2005, page 9, last paragraph (emphasis added). Therefore, in order to expedite prosecution, Applicants have amended the claims to recite "circularly permuted *β-lactamase* protein" rather than "circularly permuted protein."

The Examiner is respectfully reminded that Applicants have fairly disclosed to the public a multitude of break points useful in interaction dependent circularly permuted *β-lactamase* proteins. After providing this technical knowledge to the general public, it would be unfair to limit the claims to a single *β-lactamase* protein that competitors may easily design around by making conservative amino acid substitutions. Applicants respectfully submit that they have met their end of the patent system's *quid pro quo* and ask that, in return, the Patent Office allow claims of sufficient scope to protect Applicants' invention in the marketplace.

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C. Double Patenting

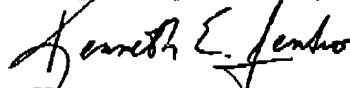
Claims 80-88 stand provisionally rejected under the judicially created doctrine of double patenting as allegedly being obvious over claims 63-66 of co-pending U.S. Application No. 09/526,106. Applicants respectfully request that this rejection be held in abeyance until patentable subject matter has been found. At that time, Applicants will take the necessary steps to obviate the double patenting rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



Kenneth E. Jenkins, Ph.D.
Reg. No. 51,846

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300

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